## REMARKS

Claims 1-10 were rejected because the Examiner considers the claims to be obvious under Section 103(a) in view of Alley et al., Nishino, and Microsoft. The examiner has not specifically stated a basis for rejecting claims 11-15, but from the application of multiple references to these claims, Applicant assumes the rejection is also for obviousness under Section 103(a). (If this is not the case, the Examiner should clarify for the record the basis for the rejection of claims 11-15.)

Applicant respectfully requests reconsideration of the rejections in view of the following remarks.

Applicant has carefully read the Alley et al. reference and respectfully submits that, among other things, the claimed server and associated server functions the Examiner has described as being present in the reference simply do not exist and are not suggested. Absent such features a prima facie case of obviousness cannot exist, and the rejections must be withdrawn. Alley et al. generally contemplates a system for synchronizing files between a desktop computer and and pen-based computer. It only contemplates synchronization between these two classes of devices, and it does not contemplate synchronization between two devices using an intermediate server device, as will be demonstrated.

The Examiner considers Alley to show a remote computer with a server program and refers to Col. 2, lines 31-34, under the Summary Of The Invention:

> In one aspect, the present invention provides a method for transferring data from a first computer system running a server program under a first operating system to a second computer system running a control program under a second operating system, the first and second computer systems being in communication through a communications medium. In one aspect, the present invention provides a method for transferring data from a first computer system running a server program under a first operating system to a second computer system running a control program under a second operating system, the first and second computer systems being in communication through a communications medium.

Page 4 - RESPONSE TO OFFICE ACTION DATED January 27, 2003
Serial No. 09/464,866

Alley et al. does not expressly define or otherwise indicate what is meant by "server

program". However, the meaning is contextually clear from the description under the Detailed

Description section at Col. 10, lines 9-lines 23, which the Examiner might have overlooked:

> In one embodiment, desktop computer 166 further includes a server program that
> communicates with software running on the remote pen-based computer. One example
> of such server software is that sold commercially as "Newton Connection Kit" by Apple
> Computer, Inc., of Cupertino, Calif. The server program runs under an operating system
> such as the Macintosh® operating system available from Apple Computer, Inc., of
> Cupertino, Calif. The pen-based computer runs a control program capable of
> exchanging data and instructions with the server program on the desktop computer,
> such as the above-described "Newton Connection Kit" software. The control program
> would run under an operating system adapted for the pen-based computer, such as the
> Newton® operating system, also available from Apple Computer.

From the foregoing, it is clear that the term "server program" relates to a program

resident on a single device, namely a desktop computer, which directly communicates with a

specific device, namely the pen-based computer. There is no basis in the foregoing passage or

elsewhere in Alley et al to assume any broader or general meaning for the term "server

program," such as in the sense of a Web server in communication with multiple computers. The

Summary Of The Invention also negates a broader meaning, describing the problem meant to

be overcome by the invention as follows:

> "[T]he present invention addresses two major short comings of pen-based computers by
> providing users of these computers greater and more simplified access to the information stored
> on less mobile desktop systems." (Col. 2, lines 26-29.)

The Examiner also considers Alley et al. to teach a software module that is not co-

located with the remote computer but rather is located on a separate physical server. The

examiner cited Col 14, lines 6-18 for this proposition. The exact language of that passage reads

as follows:

> While this invention has been described in terms of several preferred
> embodiments, there are alterations, permutations, and equivalents which fall within the
> scope of this invention. It should also be noted that there are many alternative ways of
> implementing the processes of the present invention. For example, much of the

Page 5 - RESPONSE TO OFFICE ACTION DATED January 27, 2003
        Serial No. 09/464,866

programming can be simplified by using the high-level utilities and data structures mentioned in the preceding specification. In particular, the described frame database system is preferred for simplifying the programming tasks required by the computer implemented processes of the present invention, but there are many other database and graphics systems which can be used to accomplish the same task.

The teaching that the Examiner ascribes to the foregoing passage does not exist -- if the Examiner is inferring the teaching from such ubiquitous, general catch-all language, then any rejection could be based on such language without ever citing specific detail. Obviously this cannot be the case, and there must be a clear teaching or suggestion to support an obviousness rejection.

To clarify the relationship of the first and second apparatuses relative to the intermediate server, the claims have been amended to recite that the server is remote from the server, i.e., the server is not merely a server program on the first and second apparatuses that are exchanging information through the server. Because Alley et al., alone or in combination with any other reference of record, does not teach or suggest the use of first and second apparatuses and a remote a server, no prima facie case of obviousness has been established, and the rejections of all claims 1-15 must be withdrawn, as all rejections are premised on Alley et al.
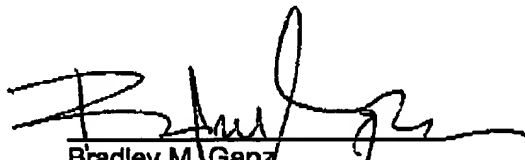
In any case, the rejections should be withdrawn because there is no suggestion or motivation in the references to combine them in the manner in which they have been combined, leaving the combination as an impermissible hindsight construction of the invention. The combination is particularly inappropriate because the Nishino reference is non-analogous art related to cellular communication systems. Applicant incorporates by reference all previous arguments as to non-obviousness.

## CONCLUSION

Applicant submits that in view of the foregoing arguments and/or amendments, the application is in condition for allowance, and favorable action is respectfully requested. The Commissioner Is hereby authorized to charge any fees, including extension fees, which may be required, or credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,

Date:  April 25, 2003

Bradley M. Ganz
Registration No. 34,170
P. O. Box 10105
Portland, Oregon 97298
Telephone: (503) 224-2713
Facsimile: (503) 296-2172
email: brad@ganzlaw.com

**Correspondence to:**

Philips Electronics North America Corporation
Intellectual Property & Standards
1000 West Maude Avenue
Sunnyvale, CA 94085-2810
Telephone: (408) 617-7700
Facsimile: (408) 617-4856
USPTO Customer Number: 24738

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Richard Bryan Sagar.

Serial No.: 09/494,866

Filed: · December 16, 1999
    Attorney Docket No.: PHA-23.884

For: SHARED ADDRESS-DATA SERVICE FOR PERSONAL
CE-EQUIPMENT

Box RESPONSE - NO FEE
Assistant Commissioner for Patents
Washington, D.C. 20231

Date: April 25, 2003

Examiner: Stephen M. D'Agosta

Art Unit: 2684

## AMENDMENT AND RESPONSE TO OFFICE ACTION DATED JANUARY 27, 2003
### Marked-up Claims

Please amend claims 1, 8 and 11 as follows:

1. (Thrice Amended) A method of transferring information in a first database (108) of a

first electronic apparatus (102) to a second apparatus (104), comprising

    uploading information from a first apparatus to a server that is remote from the

first apparatus (106), the information stored in a first database of the first apparatus for

use in the first apparatus, and the server accessible by a second apparatus that is

remote from the first apparatus and the server;

    determining whether the information is more recent than a copy of the

information stored on the server;

    updating the copy of the information with the uploaded information, if it is

determined that the uploaded information is more recent;

Page 1 - RESPONSE TO OFFICE ACTION DATED January 27, 2003
    Serial No. 09/464,866

manipulation the information at the server; and

downloading the manipulated information from the server to the second

apparatus for storage in a second database (124) of the second apparatus for use in the

second apparatus,

wherein the manipulated information can be automatically entered and updated

into the second database for use by an application in the second apparatus requiring a

predetermined data format regardless of communication compatibility between the first

apparatus and the second apparatus.

8.      (Thrice Amended) A method of providing a service for enabling to transfer

information in a first database (108) of a first electronic apparatus (102) to a second

apparatus (104), comprising:

enabling to upload information from a first apparatus to a server that is remote

from the first apparatus (106), the information stored in a first database of the first

apparatus for use in the first apparatus, and the server accessible by a second

apparatus that is remote from the first apparatus and the server;

enabling to determine whether the information is more recent than a copy of the

information stored on the server;

updating the copy of the information with the uploaded information, if it is

determined that the uploaded information is more recent;

enabling to manipulate the information at the server; and

enabling to download the manipulated information from the server to the second

apparatus for storage in a second database (124) of the second apparatus for use in the

second apparatus,

wherein the manipulated information can be automatically entered and updated

into the second database for use by an application requiring a predetermined data

format regardless of communication compatibility between the first apparatus and the second apparatus.

11. (Once Amended) A method for transferring data in a database of a first mobile terminal to a second mobile terminal, comprising:

providing a common server accessible to a first mobile terminal and a second mobile terminal, the terminals being remote from each other and the server, the first mobile terminal having at least a first application and associated first database for use in the first mobile terminal, and the second mobile terminal having at least a second application and associated second database for use in the second mobile terminal;

uploading data from the first application's first database to the common server;

associating the data with a particular user;

determining a format required by the particular user;

converting the uploaded data to conform to the format;

downloading the converted data automatically into the second database for use by the second application.

```
G A N Z

L A W
```
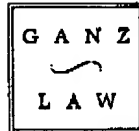
| | | | |
|---|---|---|---|
| **Date:** | April 25, 2003 | From: | Bradley M. Ganz |
| **To:** | **Attn: Stephen D'Agosta** U.S. Patent and Trademark Office, Art Unit 2674 | Regarding: | Serial No. 09/464,866; Our Ref.: PHA-23.884 |
| **Telephone:** | (703) 308-8858 | Pages | 11 + Cover Sheet |
| **Facsimile:** | (703) 872-9314 | Copies to: | |

Please find attached copies of the following sent via facsimile on April 25, 2003 to the above-referenced facsimile number:

- Transmittal Form;
- Amendment and Reply to Office Action Dated January 27, 2003; and
- Marked-up Claims.

Respectfully Submitted,
Bradley M. Ganz, Esq.